

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Pedersen et al.

Confirmation No.: 9451

Application No.: 10/657,611

Group Art Unit: 3763

Filed: September 8, 2003

Examiner: Campbell, Victoria P.

For: Flow Restrictor With Safety Feature

REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief pursuant to 37 CFR § 41.41(a)(1) is presented in response to the Examiner's Answer dated April 21, 2009. This Reply Brief is submitted by August 21, 2009, and should be entered and considered as of right because it is filed within 3 months of the Examiner's Answer and authorizations for extension of time fees is given below.

The Commissioner is hereby authorized to charge any required fees or refund excess payments to Novo Nordisk Inc. Deposit Account No. 14-1447.

I. SUMMARY

A. Status of Claims

Claim 1 is currently pending by way of the amendment under 37 C.F.R. § 41.33(b)(1), which was entered by the Examiner as noted in the Advisory Action After the Filing of an Appeal Brief. Accordingly, Appellant proceeds in the appeal of the final rejection of sole pending claim 1.

B. Issues to be Heard on Appeal

The broad issues under consideration in this appeal are:

- (1) Whether claim 1 is properly rejected under 35 U.S.C. § 102(b) as being anticipated by Craig et al, U.S. Patent No. 5,935,430 (hereafter “CRAIG”)

II. REPLY

Appellant respectfully submits that the Examiner has not adequately rebutted Appellant’s arguments made during prosecution and in Appellant’s appeal brief.

A. APPELLANT’S CLAIM 1 IS NOT ANTICIPATED BY CRAIG

1. SUMMARY OF EXAMINER’S ARGUMENTS AS TO CRAIG

The Examiner asserts that the moat disclosed in CRAIG is a safety channel as in pending claim 1. In particular, the Examiner argues that the moat structures of CRAIG are “channels in their own right and thus **MAY BE** provide with ports or aperture per Col. 10, lines 28-43.” (Examiner’s Answer at pages 4-5, emphasis added)

2. CLAIM 1 IS NOT ANTICIPATED BY CRAIG

Anticipation requires that the cited reference disclose all the features of the claim. Claim 1 requires safety channels in fluid communication with the exterior. This is not present in CRAIG even if one assumes, as the Examiner has, that the moat of CRAIG is a safety channel. As the Examiner admits at page 5 of the Answer, CRAIG does not disclose in Figure 5 that the moat is open to the exterior. Instead the Examiner’s relies upon Col. 10, lines 28-43, but this reliance is misplaced. This cited passage provides no support for the assertion that the moat is in fluid communication with the exterior. This provision merely states “that a device having a variety of apertures, ports, and the like, some of which are in fluid communication with one or more channels or other surface features. Appellants note that the definition of surface features is

distinct from the definition of moat provided by CRAIG (*See* Col. 7 and 8, respectively) and that the examples of a “surface feature” in Column 7 of CRAIG do not recite the term moat.

In the Answer, the Examiner states that she interprets moats 321 A and 321 B to be open to the exterior, but she provides no basis for how she arrives at this interpretation. Indeed, the stated purpose of the moat in CRAIG is to contain transient fluids. (*See* CRAIG, Col. 11, line 65). It thus teaches away from having the moat in fluid communication with the exterior as this would allow the fluids to drain. Draining is, of course, the opposite of containing. And, as discussed above, the Examiner admits in the Answer that the figures of CRAIG do not show the presence of an aperture with respect to the moats.¹ Without an explicit disclosure of a safety channel having a port in fluid communication to the exterior, CRAIG cannot anticipate the claimed invention. Moreover, there would be no reason to modify CRAIG to include such a feature with respect to the moats, as this would not allow the moat to function as required by CRAIG, i.e., contain the transient fluids.

III. CONCLUSION

Appellant respectfully submits that for at least all of the foregoing reasons, the Final Office Action and Examiner’s Answer fails to point out in a single prior art document each and every element as set forth in pending claim 1 with respect to CRAIG, which is a prerequisite for maintaining a rejection under 35 U.S.C. § 102. The Board is, therefore, respectfully requested to reverse the Examiner’s decision to finally reject claim 1, and to allow the application to issue in its present form.

Respectfully submitted,

Date: August 19, 2009

/Marc A. Began, Reg. No. 48,829/

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¹ See Answer at page 5, where the Examiner states that the figures “can not be conclusively relied upon to show either the presence or absence of an aperture.”